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EXAMINER
GEISEL, KARA E

ART UNIT	PAPER NUMBER
2877	

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/006,890	DE RIGAL ET AL.	
	Examiner	Art Unit	
	Kara E Geisel	2877	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Peri d for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 December 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-158* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *92-115 and 142-154* is/are allowed.

6)☒ Claim(s) *1,2,16-28,38-40,50-69,79,87-91,116-118,120-123,126,131,137-141 and 155-158* is/are rejected.

7)☒ Claim(s) *3-15,29-37,41-49,70-78,80-86,119,124,125,127-130 and 132-136* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in this application on December 10th, 2001.

Information Disclosure Statement

The information disclosure statement filed on December 10th, 2001 has been fully considered by the examiner.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 17, 19-20, 24-26, 28, 38-40, 51, 53-54, 58-60, 63, 116-117, 120-123, 126, 131, and 138-140 are rejected under 35 U.S.C. 102(b) as being anticipated by Stenz (USPN 1,741,080) as disclosed by applicant.

In regards to claim 1, Stenz discloses a matching chart comprising at least one comparison sample (fig. 3, 4) configured to simulate the appearance of a keratinous element, wherein the at least one comparison sample is configured to simulate a color and at least one appearance other than color of the element (page 1, lines 64-67).

In regards to claims 2 and 28, Stenz discloses a system as disclosed above and a matching chart further comprising a plurality of comparison samples (fig. 3).

In regards to claims 17 and 51, the comparison sample comprises a support having a substantially rectangular shape (fig. 3).

In regards to claims 19 and 53, the color and the appearance characteristic other than color is provided on at least a surface portion of the support (page 1, lines 1-12).

In regards to claims 20 and 54, the at least one comparison sample defines a hole (fig. 3, 6) to permit observation of the keratinous element through the hole (page 1, lines 72-87).

In regards to claims 24 and 58, at least one comparison sample includes an identifier associated with the color and the at least one appearance characteristic other than color (page 1, lines 98-100 and page 2, lines 1-5).

In regards to claims 25 and 59, the identifier is an alphanumeric code (page 2, lines 2-5).

In regards to claims 26 and 60, the comparison sample is configured to simulate the appearance of a keratinous element such as skin (page 1, lines 1-12).

In regards to claim 38, the system comprises at least three comparison samples (fig. 3), each sample being configured to simulate at least one of a color and an appearance characteristic other than color that differs from the other comparison samples (page 1, lines 12).

In regards to claim 39, the at least three samples comprises four comparison samples (fig. 3).

In regards to claim 40, the at least three samples comprises five comparison samples (fig. 3).

In regards to claim 63, further comprising at least one set of comparison samples, wherein the set comprises at least some of the plurality of comparison samples having at least one of substantially the same color and substantially the same appearance characteristic other than color (page 1, lines 64-71).

In regards to claim 116, Stenz discloses a method of selecting a product for application to a keratinous element (page 1, lines 9-12) comprising providing the system of claim 28, discussed above,

selecting a comparison sample of the system (page 1, lines 88-97) and selecting a product from a plurality of differing products for application to the keratinous element based on the selected comparison sample (page 1, lines 72-87).

In regards to claims 117 and 123, each of the comparison samples comprises an alphanumeric identifier and wherein selecting of the product is based on the identifier of the selected comparison sample (pages 1-2 lines 98-100 and 1-5 respectively).

In regards to claim 120, the product is a cosmetic product (page 1, lines 10-12).

In regards to claim 121, the product is a blush (page 1, lines 10-12).

In regards to claim 122, the keratinous element is skin (page 1, lines 1-7).

In regards to claim 126, the product affects the color of the keratinous element (page 1, lines 10-12).

In regards to claim 131, the system further comprises at least three comparison samples (fig. 2), wherein each sample is configured to simulate at least one of a color and an appearance characteristic that differs from the other samples (page 1, lines 60-71).

In regards to claim 138, the system comprises providing a plurality of samples as a set (fig. 1).

In regards to claim 139, the method further comprises comparing the keratinous element to each of the comparison samples to determine which comparison sample has a color and an appearance characteristic other than color that substantially corresponds to the keratinous element (page 1, lines 10-12 and 73-87).

In regards to claim 140, comparing comprises placing the keratinous element adjacent to at least a portion of the sample (page 1, lines 73-87).

Claims 64-69, 79, 88, and 90-91 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirsch et al. (USPN 5,643,341).

In regards to claim 64, Hirsch discloses a method of manufacturing a product intended for application to a keratinous element (column 5, lines 60-67) comprising providing a system comprising a plurality of comparison samples each sample being configured to simulate an appearance of a keratinous element (fig. 2) wherein each comparison sample is configured to simulate a color and at least one appearance characteristic other than color of the element (columns 7-8, lines 50-67 and 1-14 respectively), selecting at least one of the plurality of comparison samples (column 9, lines 40-51), and making a product intended for application to a keratinous element according to the color and the appearance characteristic other than color of the at least one selected comparison sample (column 9, lines 51-60).

In regards to claim 65, selecting at least one comparison sample comprises determining which of the plurality of comparison samples substantially corresponds to a color and an appearance characteristic other than color of the keratinous element to which the product is intended to be applied (column 9, lines 43-51).

In regards to claim 66, the keratinous element is hair (column 5, lines 60-63).

In regards to claim 67, the selecting of the at least one comparison sample comprises determining which of the comparison sample substantially corresponds to a color and an appearance characteristic other than color desired by a user of the product (column 1, lines 42-62).

In regards to claim 68, the product is a care product (column 5, lines 60-67).

In regards to claim 69 the product is a hair care product (column 5, lines 60-67).

In regards to claim 79, there are at least three comparison samples, each sample being configured to simulate at least one of a color and an appearance characteristic other than color that differs from the other comparison samples (fig. 2).

In regards to claim 88, providing the system comprises providing the plurality of comparison samples as a set (fig. 2 and column 7, lines 59-67).

In regards to claim 90, each comparison sample comprises an identifier, and making the product further comprises making the product based on the identifier of the selected comparison sample (fig. 2, and columns 7-8, lines 59-67 and 1-14, respectively).

In regards to claim 91, the identifier is an alphanumeric code (fig. 2, 22).

Claims 155-158 are rejected under 35 U.S.C. 102(e) as being anticipated by Bazin et al. (US Pub 2002/0065456).

In regards to claim 155, Bazin discloses a method of enabling analysis of a keratinous element comprising transmitting at least one image (page 4, ¶ 67) simulating an appearance of a keratinous element (page 1, ¶s 11-12), wherein the image is configured to simulate a color (page 3, ¶ 35) and at least one appearance characteristic other than color of the element (page 3, ¶ 27).

In regards to claim 156, the method further comprises comparing the element with at least one image to determine if the image substantially corresponds to the color and appearance characteristic of the element (page 3, ¶ 34).

In regards to claim 157, the transmitting of the image comprises transmitting the image via a network (page 4, ¶ 67).

In regards to claim 158, the method further comprises receiving information relating to a comparison between at least one keratinous element and the at least one image (page 8, ¶s 111-112).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 16, 18, 21-23, 50, 52, 55-57, 62, 118, and 137 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stenz (USPN 1,741,080) as disclosed by applicant.

In regards to claims 16, 50, and 137 the matching chart, system, and method of selecting a product are disclosed above. Although it is not disclosed, it is well known in the art to have an entire sheet compare items of a similar quantity and varying only one characteristic of the quantity, such as tone, while keeping the other characteristics of the items similar, such as having a matte finish. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, since Stenz is varying the tone of the samples, that the comparison samples are configured to have a substantially uniform brightness.

In regards to claims 18 and 52, the matching chart and system are disclosed above. The length and width of the support are merely design considerations, and would be obvious to anyone skilled in the art.

In regards to claims 21 and 55, the matching chart and system are disclosed above. The location of the hole is merely a design consideration, and would be obvious to anyone skilled in the art.

In regards to claims 22 and 56, the matching chart and system are disclosed above. The dimension of the hole is merely a design consideration, and would be obvious to anyone skilled in the art.

In regards to claims 23 and 57, the matching chart and system are disclosed above. The hole is circular (fig. 3, 6) and a dimension of it would be a diameter.

In regards to claim 62, it is very well known in the art to display colors, and color charts as an electronic image on a computer monitor.

In regards to claim 118, while Stenz does not disclose that the alphanumeric identifier on the comparison samples matches an identifier on the product to be selected, the comparison sample is used for selecting the product (page 1, lines 90-97), and it would be obvious to one of ordinary skill to make this easier on the salesperson to choose the right product by code-matching the product and the sample.

Claims 27, 61, and 141 rejected under 35 U.S.C. 103(a) as being unpatentable over Stenz (USPN 1,741,080), as disclosed by applicant, in view of Kamen et al. (USPN 5,150,791).

In regards to claims 27, 61, and 141, a system, method, and a matching chart are disclosed above. Stenz does not disclose that the comparison samples are configured to be displayed on a package of a product intended for application to a keratinous element. However, it is well known in the art to have a display corresponding to different colors and shades of a cosmetic item, and then having the color and shade of a particular item selected from the display be identified by the same color and shade on the package of the item.

For example, Kamen discloses a module for displaying a cosmetic color (fig. 4). The module is formed and then can be placed on a color chart (fig. 3). The corresponding color can also be attached to the package or case of the cosmetic (figs. 1 and 2) to show the color of the product inside. Therefore, one can select a color from the color chart, and then match the color to the cosmetic by the module attached on the cosmetic case (column 3, lines 7-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have each of the comparison samples of Stenz's chart be configured to be displayed on a package of a product intended for application to a keratinous element

in order to help a user identify the product a user has chosen after choosing the sample from the system or matching chart.

Claims 87 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch et al. (USPN 5,643,341).

In regards to claim 87, the method of manufacturing is disclosed above. Although it is not disclosed, it is well known in the art to have an entire sheet compare items of a similar quantity and varying only one characteristic of the quantity, such as tone, while keeping the other characteristics of the items similar, such as having a matte finish. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, since Hirsch is varying the tone of the samples, the comparison samples are configured to have a substantially uniform brightness.

In regards to claim 89, the method of manufacturing is disclosed above. It is very well known in the art to determine which comparison sample corresponds to the keratinous element by placing the element adjacent to a portion of the sample, and it would be very well known in the art to do so.

Allowable Subject Matter

Claims 92-115 and 142-154 are allowed.

Claims 3-15, 29-37, 41-49, 70-78, 80-86, 119, 124-125, 127-130, and 132-136 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

As to claims 3, 29, 70, and 119 the prior art of record, taken alone or in combination, fails to disclose or render obvious a matching chart, a system, a method of manufacture, or a method of selecting a product wherein at least one appearance characteristic other than color is brightness, in combination with the rest of the limitations of claims 3, 29, 70, and 119.

As to claims 4, 31, 72, and 127 the prior art of record, taken alone or in combination, fails to disclose or render obvious a matching chart, a system, a method of manufacture, or a method of selecting a product wherein at least one appearance characteristic other than color is relief, in combination with the rest of the limitations of claims 4, 31, 72, and 127.

As to claims 5, 33, 74, and 128 the prior art of record, taken alone or in combination, fails to disclose or render obvious a matching chart, a system, a method of manufacture, or a method of selecting a product wherein at least one appearance characteristic other than color is color non-uniformity, in combination with the rest of the limitations of claims 5, 33, 74, and 128.

As to claims 6, 36, 77, and 130 the prior art of record, taken alone or in combination, fails to disclose or render obvious a matching chart, a system, a method of manufacture, or a method of selecting a product wherein at least one appearance characteristic other than color is non-uniformity of relief, in combination with the rest of the limitations of claims 6, 36, 77, and 130.

As to claims 7, 41, 80, and 132 the prior art of record, taken alone or in combination, fails to disclose or render obvious a matching chart, a system, a method of manufacture, or a method of selecting a product wherein at least one comparison sample is configured to have brightness non-uniformity, in combination with the rest of the limitations of claims 7, 41, 80, and 132.

As to claims 12, 46, 83, and 135 the prior art of record, taken alone or in combination, fails to disclose or render obvious a matching chart, a system, a method of manufacture, or a method of selecting a product wherein at least one comparison sample comprises a relief pattern configured to provide non-uniform brightness, in combination with the rest of the limitations of claims 12, 46, 83, and 135.

As to claim 92, the prior art of record, taken alone or in combination, fails to disclose or render obvious a method of monitoring treatment of a keratinous element with a product comprising determining whether at least one of the color and the appearance characteristic of the element to which a product has

been applied has changed after applying the product by comparing the elements of a comparison sample of the system, in combination with the rest of the limitations of claim 92.

As to claim 124, the prior art of record, taken alone or in combination, fails to disclose or render obvious a method of selecting a product for application to a keratinous element wherein a color and a brightness differs for each of the plurality of products, in combination with the rest of the limitations of claim 124.

As to claim 125, the prior art of record, taken alone or in combination, fails to disclose or render obvious a method of selecting a product for application to a keratinous element wherein the product affects the relief of the keratinous element, in combination with the rest of the limitations of claim 125.

As to claim 142, the prior art of record, taken alone or in combination, fails to disclose or render obvious a method of treating a keratinous element comprising treating the keratinous element based on the selected comparison sample, in combination with the rest of the limitations of claim 142.

Examiner's Remarks

Claims 92 and 142 have been allowed over the prior art of record. If claim 28 is to be cancelled, the claims will need to be amended to include the limitations of claim 28 in order for their allowability to be maintained, and so they will not be considered incomplete.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kara E Geisel whose telephone number is 703 305 7182. The examiner can normally be reached on Monday through Friday, 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 703 308 4881. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9318 for regular communications and 703 872 9319 for After Final communications. For inquiries of a general nature, the Customer Service fax number is 703 872 9317.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1782.

F.L. Evans
Primary Examiner
Art Unit 2877

K.G.

KEG
May 15, 2003